

Appl. No. : 10/789,526
Filed : February 26, 2004

REMARKS

Applicants thank the Examiner for her review of the instant application.

Applicants have canceled claims 11-12, and 48-49, without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the cancelled claim in this or any other patent application.

Applicants have amended the claims as detailed below, and assert that the amendments to the claims are fully supported throughout the specification as filed, including the claims, and therefore the amendments do not constitute new matter.

Applicants have amended claims 3-7, 9, 13 and 20-23 to replace "A compound" with "The compound" to clarify that the claims are dependent, and therefore incorporate all of the elements and limitations of the claim(s) from which they depend. Claim 1 is amended to recite "an at least 8 consecutive nucleobase portion of SEQ ID NO: 19; and wherein said compound is at least 90% complementary with SEQ ID NO: 4 as measured over the entirety of said compound." Support for this amendment can be found, for example, at page 17, line 12, through page 18, line 8, and page 20, line 10, through page 21, line 26. Claim 13 is amended to recite "The compound according to claim 1 comprising at least 95% complementarity with SEQ ID NO: 4 as measured over the entirety of said compound." Support for this amendment can be found, for example, at page 17, line 12, through page 18, line 8. Claim 20 has been amended to recite "modified sugar," support for which can be found, for example, at page 36, line 16, through page 38, line 5. Claim 21 is amended to recite "The compound according to claim 20, wherein the modified sugar is selected from the group consisting of a 2'-O-(2-methoxyethyl), and a 4'-(CH₂)_n-O-2' bridge, wherein n is 1 or 2." Support for this amendment can be found, for example, at page 36, line 16, through page 38, line 5. Claim 50 is amended to recite, "15 to 30 nucleobases in length," "comprises at least 8 consecutive nucleobases," "is at least 80% complementary...as measured over the entire length of said compound." Support for this amendment can be found, for example, at page 17, line 12, through page 18, line 8, and page 20, line 10, through page 21, line 26.

Applicants have added new claims 58-59, 61, and 64-65, support for which can be found, for example, at page 17, line 12, through page 18, line 8. Support for new claim 60 can be found,

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for example, at page 20, lines 10-29. Support for new claim 62 can be found, for example, at page 82, lines 3-9. Support for new claim 63 can be found, for example, at page 17, line 12, through page 18, line 8, page 20, line 10, through page 21, line 26, and page 82, lines 3-9. Support for new claims 66-68 can be found, for example, at original claims 4, and 21-23, and page 79, line 15, through page 80, line 2.

Claims 1, 3-7, 9, 13, 20-23, 46-47, and 50-68 are presented for examination. For the reasons below, Applicants respectfully traverse the rejections of the pending claims.

35 U.S.C. § 102(e) – Anticipation

Claims 1, 3-6, 8, 10-13, 20-23, and 46-49 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Dobie et al., apparently for the reasons of record. Applicants respectfully traverse.

In the Office Action mailed June 13, 2006, the Examiner stated that Dobie disclosed “a chimeric oligonucleotide comprising a 10-nucleobase sequence that is 100% identical to a sequence of SEQ ID NO: 19 of the instant invention,” citing to SEQ ID NO: 41 of Dobie.

As amended, claim 1 recites:

1. A compound from 12 to 50 nucleobases in length targeted to a nucleic acid molecule encoding growth hormone receptor, wherein said compound comprises an at least 8 consecutive nucleobase portion of SEQ ID NO: 19; and wherein said compound is at least 90% complementary with SEQ ID NO: 4 as measured over the entirety of said compound.

Dobie does not disclose each and every limitation of claim 1, and therefore cannot anticipate claim 1, or any claims dependent therefrom. In particular, Dobie discloses an oligonucleotide that is 20 bases in length, of which only 14 are complimentary to SEQ ID NO: 4, and thus the oligonucleotide of Dobie is not “at least 90% complementary with SEQ ID NO: 4 as measured over the entirety of said compound.” Dobie is instead only 70% complimentary to SEQ ID NO: 4. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. § 102(e) rejection of the pending claims over Dobie et al.

Similarly, the sequences from Dobie and the other references cited in the previous Office Action do not anticipate any of pending independent claims 1, 50, and 63. Claim 50 recites a compound that is 15 to 30 nucleobases in length with at least 80% complementarity to SEQ ID

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NO: 4; and claim 63 recites 8 to 80 nucleobases in length with at least 90% complementarity to SEQ ID NO: 4. As mentioned above, the 20 base oligonucleotide of Dobie is only 70% complementary. The 12 base oligonucleotide of Wang et al. is approximately 84% complementary to SEQ ID NO: 4. The 21 base oligonucleotide of Francisco et al. is about 62% complementary to SEQ ID NO: 4. SEQ ID NO: 16 of Baker et al. is 20 nucleobases in length, and 50% complementary to SEQ ID NO: 4, while the 20 nucleobase SEQ ID NO: 293 of Baker et al. is 45% complementary.

For at least these reasons, none of the sequences from the cited references disclose each and every limitation of independent claims 1, 50 and 63, and therefore they cannot anticipate these claims or any claims which depend from them.

35 U.S.C. § 112, second paragraph – Indefiniteness

The Examiner rejects claims 3-7, 9, 11-13, and 20-23 under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, claims 3-7, 9, 11-13, and 20-23 are rejected for reciting the phrase “a compound of claim 1” or “a compound of claim 4,” rather than “the compound of claim 1,” or “the compound of claim 4.” The Examiner believes that it is unclear if the claims are intended to be dependent claims that encompass all of the limitations recited in independent claim 1 or claim 4.

As amended, the pending claims recite “The compound of claim...” to clarify that the claims are dependent. Applicants therefore request reconsideration and withdrawal of this rejection.

Claims 7 and 9 are rejected for reciting RNA oligos, while they depend indirectly from claim 1 which recites deoxynucleotides.

As amended, claim 1 no longer recites the limitation “comprises deoxynucleotides.” Applicants therefore request reconsideration and withdrawal of this rejection.

35 U.S.C. § 112, first paragraph – Written Description, New Matter

Claims 50-57 are rejected under 35 U.S.C. § 112, first paragraph, as containing new matter for reciting “at least 12 consecutive nucleobases,” which the Examiner asserts is not found in the specification as filed.

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Without acquiescing to the Examiner's assertion, Applicants note that pending claim 50 recites "at least 8 consecutive nucleobases." Applicants therefore request reconsideration and withdrawal of this rejection.

Provisional Non-statutory Obviousness-type Double Patenting

The Examiner provisionally rejects claims 1, 3-6, 8, 10-13, 20-23, and 46-57 on the ground of obviousness-type double patenting over copending Application Serial No. 10/927,466 in view of Dobie et al.

In light of the above arguments and amendments, Applicants respectfully submit that the provisional obviousness-type double patenting rejections over copending Application Serial No. 10/927,466 is the sole remaining rejections in the instant application. M.P.E.P. § 804 provides in relevant part:

If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw the rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. *M.P.E.P. § 804(I)(B)*.

Consistent with M.P.E.P. § 804, Applicants respectfully request that the remaining provisional double patenting rejection be withdrawn and the instant Application be allowed to issue. In the event that double patenting issues remain during the prosecution of the 10/927,466 application, Applicants will consider filing an appropriate terminal disclaimer.

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CONCLUSION

In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

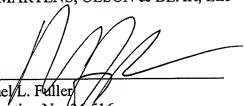
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 27, 2007

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